REMARKS/ARGUMENTS

Claims 11-40 remain in this application.

Objection to the Specification

The amendment filed January 23, 2006 ("Prior Amendment") was objected to under 35 USC 132(a) because it was not accompanied by a "statement executed by the applicant, or practitioner representing applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter." See Page 2 of the Office Action. Per 37 CFR 1.57(f), Applicants hereby confirm that the material that was inserted in the Prior Amendment to replace the paragraph beginning at page 4, line 10 was the material previously incorporated by reference and that the amendment contains no new matter. Accordingly, Applicants respectfully request that this objection be withdrawn.

Rejection Under 35 USC 112 first Paragraph

I

Claims 11-40 were rejected under 35 USC 112, First Paragraph for "while being enabling for treating inflammation, does not reasonably provide enablement for treating any other disorder." See Pages 2-3 of the Office Action. Applicants respectfully disagree.

Independent claim 11 of the present application recites the invention of a "method of administering an extract of feverfew to a human, said method comprising topically applying a composition comprising an extract of feverfew to said human wherein said extract is substantially free of α-unsaturated γ-lactone." According to the Office Action, plant extract compositions have pharmaceutical properties and are used as pharmaceuticals. . . . These include ailments that are notoriously difficult to treat such as viral infection and skin tumors." See pages 2-3 of the Office Action. Applicants, however, have not specifically claimed any such pharmaceutical uses. Thus, Applicants contend that the fact that topically applied feverfew extract may have such pharmaceutical utility, and thus fall within the scope of their claim, is irrelevant to the analysis of enablement as Applicants are not required to enable every possible utility of their invention. Rather, Applicants, as set forth in 35 USC 112, are only required to

enable one to make and use the "invention," which as set forth in independent claim 11 is a "method of administering an extract of feverfew to a human, said method comprising topically applying a composition comprising an extract of feverfew to said human wherein said extract is substantially free of α-unsaturated γ-lactone." Applicants have enabled one of skill in the art to make and topically apply such composition containing an extract of feverfew. Thus Applicants have fully enabled the claimed invention. As stated above, Applicants are unaware of a requirement to enable every possible utility of a claimed invention, especially utilities that are not recited in the claims. As applicants for a patent on a novel pharmaceutical composition, or any other novel composition, are not required to enable every possible utility for their composition, so should the Applicants of the present application also not also be required to enable all such utilities.

Accordingly, Applicants respectfully request that the above rejection under 35 USC 112 be withdrawn.

II

Claims 11-40 were also rejected under 35 USC 112, First Paragraph for "failing to comply with the written description requirement." See Pages 3-4 of the Office Action. Applicants respectfully disagree.

According to the Office Action, the "claim(s) are drawn to a method of topically administering a feverfew extract that is substantially free of alpha unsaturated gamma lactones. No specific use is claimed; thus, the claims encompass administering the feverfew for thousands of possible uses. . . . In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been sufficiently described." See Page 4 of the Office Action. Applicants, however, are not claiming a genus. Rather, as set forth in claim 11, Applicants are claiming a single method, the "method comprising topically applying a composition comprising an extract of feverfew. . . ." The various utilities of this method, such as the treatment of inflammation, are not an element set forth in the pending claims.

Applicants do not believe that reciting in the specification all of the ultimate utilities of a method is required. Rather, as set forth in 35 USC 112, the specification need only "contain a written description of the invention," not all of the utilities of the invention. Applicants have provided a written description of how to manufacture and topically apply the

claimed feverfew composition as recited in the pending claims. Thus, Applicants contend that they have fully complied with the written description requirement for their claimed invention. As applicants for a patent on a novel pharmaceutical composition, or any other novel composition, are not required to provide written description for every possible utility for their composition, so should the Applicants of the present application also not also be required to provide a written description of all such utilities.

Accordingly, Applicants respectfully request that the above rejection under 35 USC 112 be withdrawn.

Double Patenting

Claims 11-40 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of US Patent No. 6,410,062. See page 5 of the Office Action. Applicants agree to submit an appropriate terminal disclaimer upon the indication of allowable subject matter in the present application.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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